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**FACSIMILE TRANSMITTAL SHEET**

TO:	Steven P. Griffin	FROM:	Adenike Adewuya
COMPANY:	U.S. Patent and Trademark Office	DATE:	7/29/2003
FAX NUMBER:	(703) 872-9373	TOTAL NO. OF PAGES INCLUDING COVER:	14
PHONE NUMBER:	(703) 308-1164	SENDER'S REFERENCE NUMBER:	SP01-116
RE:	Petition under MPEP §710.06	YOUR REFERENCE NUMBER:	09/848,903

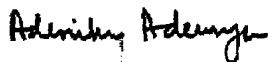
☒ URGENT   ☒ FOR REVIEW   ☐ PLEASE COMMENT   ☐ PLEASE REPLY   ☐ PLEASE RECYCLE

**NOTES/COMMENTS:**

Dear Steven,

Thanks for your help in sorting out the correspondence address issue in the referenced case. As requested, a petition to reset period for reply in the case is enclosed.

With best regards,



Adenike Adewuya  
Reg. No. 42,254

4606 FM 1960 West, Suite 400, Houston, Texas 77069 | Tel 281.477.3450 | Fax 281.477.3455

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FILE No.798 07/29 '03 10:37  
07/18/03 FRI 14:17 FAX 7032055406ID:CORNING PATENT DEPT  
GP 1700 FAX MACHINE

FAX:8079742407

PAGE 2  
001

## U. S. Patent and Trademark Office

Technology Center 1700

Facsimile Transmission

Date:

7/18/03

10 pages

To:

Adenike Adewunya

Organization:

Phone #:

281-477-3450

Fax #:

281-477-3455

(607) 974-3848

From:

Steve Griffin

Phone #:

(703) 308-1164

Fax #:

(703) 672-9373

Comments:

09/348903

Number of Pages including this Cover Page:

63

If you have not received all pages of this transmission, please contact this Examining Group as soon as possible at the above telephone number.

For PTO Staff

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FILE No. 798 07/29 '03 10:37 ID: CORNING PATENT DEPT  
07/18/03 FRI 14:17 FAX 7033055408FAX: 6079742407  
GP 1700 FAX MACHINEPAGE 3  
0002

## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20591  
www.uspto.gov

APPLICATION NO.	FILED DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/246,903	05/04/2001	David L. Tennant	SFD-116	3713

23911 7393 04/02/2001  
ROSENTHAL & OSHA L.L.P.  
1221 MCKINNEY AVENUE  
SUITE 2800  
HOUSTON, TX 77010

RSW

EXAMINER

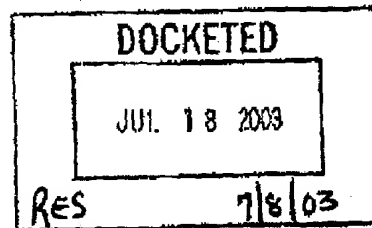
FIORILLA, CHRISTOPHER A

ART UNIT PAPER NUMBER

1731

DATE MAILED: 04/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



FILE No. 798 07/29 '03 10:37 ID: CORNING PATENT DEPT FAX: 6079742407  
 07/18/03 FRI 14:11 FAX (US) 0000000000 GP 1700 FAX MACHINE

PAGE 4  
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<b>Office Action Summary</b>		Application No.	Applicant(s)	
		09/848,903	TENNENT ET AL.	
		Examiner	Art Unit	
		Christopher A. Florita	1731	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply by mail, by statute, causes the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may require any earned patent term adjustment. See 37 CFR 1.704(d).

**Status**

1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 463 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-39 and 45-60 is/are pending in the application.

4a) Of the above claim(s) 28-34 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-27, 35-39 and 45-60 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(a) (to a provisional application).  
 a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-822)  
 2) ☐ Notice of Opposition's Patent Drawing Review (PTO-846)  
 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 24.  
 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
 5) ☐ Notice of Informal Patent Application (PTO-162)  
 6) ☐ Other: \_\_\_\_\_

U.S. Patent and Trademark Office  
 PTO-326 (Rev. 04-01)

Office Action Summary

Part of Paper No. 3

FILE No. 798 07/29 '03 10:37 ID: CORNING PATENT DEPT  
07/18/03 PRI 14:18 FAX 7033055408FAX: 6079742407  
GP 1700 FAX MACHINEPAGE 5  
14004Application/Control Number: 09/848,903  
Art Unit: 1731

Page 2

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless—

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States; before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 7, 9-22, 24-27, 35-39, and 45-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al. Pub. No. US 2002/0005051

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Brown et al. discloses a process of making silica by delivering a silica precursor comprising a pseudohalogen (i.e. silicon tetraisocyanate) to a conversion site; and passing the silica precursor through a flame to produce silica soot. Brown et al. also discloses consolidating the preform. See paragraphs [0056]-[0058] and paragraph [0096].

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

FILE No. 798 07/29 '03 10:37 ID: CORNING PATENT DEPT FAX: 6079742407  
07/18/03 PRI 14:19 FAX 7033055408 CP 1700 FAX MACHINE

PAGE 6  
0095

Application/Control Number: 09/848,003

Page 3

Art Unit: 1731

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(a) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-27, 35-39 and 45-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (Pub. No. 2002/0005051) in view of Brown et al. (6,378,337).

'337 discloses that deposited silica may be consolidated simultaneously with deposition or after deposition. '337 also discloses utilizing a plasma for deposition. It would have been obvious to use these limitation in the process of 2002/0005051 in order to optimize the process. Consolidating simultaneously with deposition would eliminate a separate deposition step. Use of a plasma would be obvious in view of the generic disclosure of the primary reference.

The use of CH<sub>4</sub> as a fuel for forming silica soot is well known in the art and it would have been obvious to one skilled in the art at the time of the invention to use this well known material in view of its known properties to optimize the process.

FILE No.798 07/29 '03 10:37 ID:CORNING PATENT DEPT FAX:6079742407  
U1/10/03 PRI 14:18 PAA /036066195 GP 1700 KAL MACHINEPAGE 7  
12006

Application/Control Number: 09/843,903

Page 4

Art Unit: 1731

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Fiorilla whose telephone number is 703-308-0674. The examiner can normally be reached on M-F, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Christopher A. Fiorilla  
Primary Examiner  
Art Unit 1731

FILE No. 798 07/29 '03 10:38 ID: CORNING PATENT DEPT

FAX: 607 974 2407

PAGE 8

41007

## Notice of References Cited

Application/Control No.  
09/848,903Applicant(s)/Patent Under  
Reexamination  
TENNENT ET AL.Examiner  
Christopher A. FiorilloArt Unit  
1731

Page 1 of 1

U.S. PATENT DOCUMENTS				
*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
A	US-6378337	04-2002	Brown et al.	
B	US-2002/0005051	01-2002	Brown et al.	
C	US-			
D	US-			
E	US-			
F	US-			
G	US-			
H	US-			
I	US-			
J	US-			
K	US-			
L	US-			
M	US-			

Document Number			FOREIGN PATENT DOCUMENTS		
*	Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N				
	O				
	P				
	Q				
	R				
	S				
	T				

NON-PATENT DOCUMENTS		
*		

NON-PATENT DOCUMENTS		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
*	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (1) See MPEP § 707.05(a).  
Dates in MM-YYYY format are publication dates. Classifications may be US or Foreign.  
U.S. Patent and Trademark Office  
PTO-892 (Rev. 01-2001)

Notice of References Cited

Part of Paper No. 8



FILE No. 798 07/29 '03 10:38 ID: CORNING PATENT DEPT

FAX: 8079742407

PAGE 9

07/18/03 PK1 14:20 FAX 7033055408

CP 1700 FAX MACHINE

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**INFORMATION DISCLOSURE CITATION**  
 (Use several sheets if necessary)

01PE  
 JUL 18 2003  
 CORNING PATENT DEPT

Sheet Number (Optional)  
 06499.029001:SPV2-116

Application Number  
 89/848,903

Applicant(s)  
 David L. TENNENT et al.

Filing Date  
 05/04/2001

Corrig Art Date  
 1731

**U.S. PATENT DOCUMENTS**

EXAMINER INITIAL	REF	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE
CF	A1	5,152,819	10/06/92	Blackwell et al.	65	3.12	08/26/91
CF	A2	4,877,938	10/31/89	Rau et al.	219	121.59	09/24/87
CF	A3	4,714,589	12/3/87	Anwerda et al.	427	39	06/30/86
CF	A4	4,482,730	09/10/83	Edahiro et al.	65	3.12	12/16/80
CF	A5	5,288,518	02/21/94	Houma	427	255.1	06/05/92
CF	A6	4,737,379	04/11/88	Hudgens et al.	427	39	03/31/87
CF	A7	5,876,798	03/02/99	Vassiliev	427	255.3	12/29/97
CF	A8	5,800,977	09/01/98	Maeda et al.	427	535	09/09/96

**FOREIGN PATENT DOCUMENTS**

REF	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	Translation
						YES NO
CF	A9	WO 98/27140	06/25/98	PCT		
CF	A10	WO 99/02459	01/21/99	PCT		

**OTHER DOCUMENTS** (Including Author, Title, Date, Pertinent Pages, Etc.)

CF	A11	The Chemistry of the Halogens and the Noble Gases, Problems, pp 790-791
CF	A12	Carbon, Chapter 8 - Cyanides and Other Carbon-Nitrogen Compounds, pp. 336-343

EXAMINER: *CA F...*

DATE CONSIDERED: 4/4/03

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP Section 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Form PTO-A820  
 (also form PTO-1449)

PGAL/REV10

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SHEET 1 OF 1

FILE No. 798 07/29 '03 10:38

ID: CORNING PATENT DEPT

FAX: 6079742407

PAGE 10

07/18/03 FRI 14:20 FAX 7033055408

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## FORM PTO-1449 (MODIFIED)

LIST OF PATENTS AND  
PUBLICATIONS  
FOR APPLICANTS INFORMATION  
DISCLOSURE STATEMENT

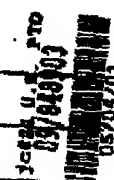
ATTORNEY DOCKET NO.

SP01-116

SERIAL NO.

APPLICANT Tennent et al.

FILING DATE

1/29/03  
GROUP

 03/08/03  
10:38:00  
10/20/03

## REFERENCE DESIGNATION

## U.S. PATENT DOCUMENTS

Examiner Initial		Document Number	Date	Name	Class	Sub-Class	Filing Date If Approp.
CF	AA	4,629,485	2/16/86	Berkey	65	3.11	9/26/83
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

## FOREIGN PATENT DOCUMENTS

		Document Number	Date	Country	Class	Sub-Class	Translation Yes No
	AL						
	AM						
	AN						
	AO						
	AP						
	AQ						

## OTHER ART (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	
	AS	
	AT	
	AU	
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	AW	

EXAMINER:

ca 702

DATE CONSIDERED:

4/4/03

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPSP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Information Disclosure Statement-PTO-1449 (Modified)

FILE No. 798 07/29 '03 10:38 ID: CORNING PATENT DEPT

FAX: 607 974 2407

PAGE 11

0010

07/15/03 PM 14:21 FAX 7033055408

GP 1700 FAX MACHINE

FORM PTO-1449 (MOI) (ED)

ATTORNEY DOCKET#

SERIAL NO.

LIST OF PATENTS AND  
PUBLICATIONS  
FOR APPLICANTS INFORMATION  
DISCLOSURE STATEMENT

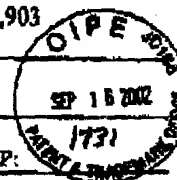
SP01-116

09/848,903

APPLICANT Tennent et al.

FILING DATE 5/4/01

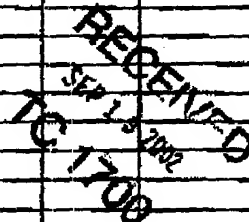
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## REFERENCE DESIGNATION

## U.S. PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Name	Class	Sub-Class	Filing Date if Approp.
	AA					
	AB					
	AC					
	AD					
	AE					
	AF					
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	AH					
	AI					
	AJ					
	AK					



## FOREIGN PATENT DOCUMENTS

		Document Number	Date	Country	Class	Sub-Class	Translation Yes No	
CE	AL	WO 02/21217	3/14/02	USA	G03F	9/00	X	
	AM							
	AN							
	AO							
	AP							
	AQ							

## OTHER ART (Including Author, Title, Date, Pertinent Pages, etc.)

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EXAMINER:

ca 700

DATE CONSIDERED:

4/4/03

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Information Disclosure Statement-PTC-1449 (Modified)